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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,844	11/19/2001	Mark David Siegel	23679-7005	4461
<p>7590 03/05/2007</p> <p>MCCUTCHEN, DOYLE, BROWN & ENERSEN Suite 1800 Three Embarcadero Center San Francisco, CA 94111-4067</p>			EXAMINER COBURN, CORBETT B	
			ART UNIT 3714	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	03/05/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/042,844	SIEGEL ET AL.	
	Examiner Corbett B. Coburn	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06 December 2006.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-46 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-46 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) Notice of Informal Patent Application
6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 45 & 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe scanning barcodes twice to provoke a battle. (See paragraphs 0070-0071.)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12, 14, 15 & 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa (JP 2000308,763) in view of Diablo (Blizzard Entertainment, 30 November 1996).

Claims 1: Ebisawa teaches a gaming device (32) with a scanner (40) for scanning a barcode corresponding to a product identification (paragraph 0001). There is a processing means (38) for receiving the barcode from the scanner. The processor

translates the barcode into game data and determines whether the game data are compatible game data. There is a storage medium for storing the compatible game data. (0009) Ebisawa may or may not teach the division of characters into groups where members of the group do not attack each other and are controlled by the characters – it is difficult to tell from the translation. However, this is extremely common in the art. Diablo is merely one example. In Diablo, there is an online version in which groups of characters are under the control of players band together to play the game in a cooperative fashion. These characters do not attack each other – they only attack monsters (a second group). Basically, this is how cooperative adventure games work. The players kill the monsters and the monsters try to kill the players, but when cooperating, the players do not kill the players. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ebisawa in view of Diablo to divide the characters into groups whose members do not attack fellow group members and are under the control of the players in order to implement a cooperative adventure game.

Regarding the newly added limitation “wherein the at least two characters are controllable by at least one user”, this clearly does not change the game. Players of any game may band together and not attack each other. Furthermore, if only one player controls multiple players, then the single player can easily determine not to attack himself.

Claim 2: Diablo teaches item data (i.e., magical items) where at least one player can use the item.

Claim 3: The gaming device is a handheld gaming device. (Figs 4 & 9)

Claim 4: The scanner (40) inherently has a light-emitting diode.

Claim 5: There is a screen (25 or 44) for displaying a menu (Fig 6 & 0118) according to signals from the processor (38).

Claim 6: The storage medium includes a look-up table (“stock information”) to which the processor (40) refers when it translates the barcode into game data. The look-up table correlates a plurality of different barcodes to a plurality of different game data. (0013-0018 & 0059-0060)

Claims 7-10: Ebisawa teaches reading barcodes but does not teach European Article Numbering code, Universal Product Code, Global Trade Item Number code and Global Location Number code, are all equivalent types of barcodes and are disclosed as such by Applicant. They are equivalent to the JAN disclosed by Ebisawa. (0052) They are used to mark products in different parts of the world. For instance, the EAN is preferred for use in Europe. The UPC is used in the United States. It would have been obvious to one of ordinary skill in the art to have used one (or all) of the above mentioned barcode formats to allow players in different parts of the world to use the invention.

Claim 11: Ebisawa’s gaming device includes a speaker. (26 & paragraph 0046)

Claims 12, 14 & 15: Ebisawa teaches that the processing means determines when the game data are incompatible game data (i.e., data corresponding to enemy characters) (0035 & 0061) and determines whether a contest (a battle) will be staged on the screen based on that determination (i.e., waging-war mold [sic]). (0073)

Claims 30-34: Ebisawa teaches a barcode on an arbitrary household product that is unrelated to the gaming device (i.e., a can of juice) that identifies a company and the product sold by the company. (0055-56) The barcode is translated into gaming data related to the gaming device.

5. Claims 13, 16, 17, 23-29 & 35-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa & Diablo as applied to claim 1 or 12 in view of Ng (US Patent Number 5,971,855).

Claims 13 & 16: Ebisawa & Diablo teach the invention substantially as claimed, including graphically displaying a battle between characters represented by compatible and incompatible data. Ebisawa appears to teach linking gaming machines via a communications port (Fig 10), but due to the poor quality of the machine translation, Examiner cannot be certain. Ng clearly teaches to teach linking gaming machines via a communications port (Fig 1A & Abstract) in order to facilitate play between two players. This increases the enjoyment to be had from the gaming device. (Col 2, 57-60) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ebisawa in view of Ng to link gaming machines via a communications port in order to facilitate play between two players, thus increasing the enjoyment to be had from the gaming device.

Claims 17, 24: Ng's communication port has a first tab for fitting into a first slot of the second gaming device and a second slot for receiving a second tab of the second gaming device (Fig 1A) and a plurality of contacts for transmitting data between the two gaming devices. (Col 3, 15 & 16)

Claim 23: Claim 23 is a combination of claims 1-4 & 16, which see.

Claims 25 & 26: The physical shape and color of the case (i.e., in the form of a logo associated with and a color associated with the game data) are a matter of aesthetic design choice. A red case is not patentably distinct from a blue case, nor is one with a particular logo patentably distinct from a case with another logo.

Claim 27: Both Ebisawa and Ng have screens and buttons on one side of the case. Ebisawa teaches the display of menus (Fig 6) and by necessity selecting choices from the menu using the control buttons.

Claim 28: Ng's coupling device is disposed on a first side of the case. (Fig 1A)

Claim 29: Claim 29 is a combination of claims 1, 2, 6, 8, & 16, which see.

Claims 35-39: Ebisawa teaches a barcode on an arbitrary product that is unrelated to the gaming device (i.e., a can of juice) that identifies a company and the product sold by the company. (0055-56)

Claims 40-44: Ebisawa teaches the use of JAN instead of UPC. As discussed above in connection with claims 7-10, JAN and UPC are obvious equivalents.

Response to Arguments

6. Applicant's arguments filed 6 December 2006 have been fully considered but they are not persuasive.
7. Applicant's arguments concerning control of the groups of characters are addressed in the rejection above.
8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would know of the popularity of cooperative online adventure games.

Conclusion

10. This is an RCE of applicant's earlier Application No. 10/042,844. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE** MONTHS from the mailing date of this action. In the event a first reply is filed within **TWO**

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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**CORBETT B. COBURN
PRIMARY EXAMINER**

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